

REMARKS

Favorable reconsideration of this application, as presently amended and in light of the following discussion, is respectfully requested.

Claims 1, 2, 8, 10, 11, 13-17, 23, 24, 30, 32, 33, 35-39, 45-48, 50-52, and 54 are currently pending. Claim 54 has been added; and Claims 1, 16 and 23 have been amended by the present amendment. The changes to the claims are supported by the originally filed specification and do not add new matter.

In the outstanding Office Action, Claim 16 was objected to as containing an informality; Claims 1-4, 8-10, 12-15, 23-26, 31, 32, 34-37, 45, 46, 48, and 50-52 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,219,694 to Lazaridis et al. (hereinafter “the ‘694 patent”) in view of U.S. Patent No. 6,522,421 to Chapman et al. (hereinafter “the ‘421 patent”);<sup>1</sup> Claims 11, 16, 17, 30, 33, 38, and 39 were rejected under 35 U.S.C. § 103(a) as being unpatentable over the ‘694 and ‘421 patents, further in view of U.S. Patent No. 5,951,636 to Zerber (hereinafter “the ‘636 patent”); and Claim 47 was rejected under 35 U.S.C. § 103(a) as being unpatentable over the ‘694 and ‘421 patents, further in view of U.S. Patent No. 6,108,492 to Miyachi (hereinafter “the ‘492 patent”).

Applicants respectfully submit that the objection to Claim 16 is rendered moot by the present amendment to Claim 16. Claim 16 has been amended to depend from Claim 13. Accordingly, the objection to Claim 16 is believed to have been overcome.

Amended Claim 1 is directed to a method of processing messages, comprising: (1) receiving an electronic mail message by a computer; (2) determining, by the computer, which of the following mutually exclusive conditions is true: (a) a content of the received message is intended to be read or viewed by a user, and (b) the content of the received message

---

<sup>1</sup> However, Applicants note that Claims 3, 4, 9, 12, 25, 26, 31, and 34 were previously canceled.

provides an instruction to an attached printing device associated with the computer, by detecting a characteristic of the message, wherein the content of the received message does not include print data to be printed by the attached printing device and the instruction to the attached printing device is unrelated to printing of data included in or attached to the received message, the attached printing device including a processor; (3) transmitting a communication from the computer to the attached printing device through a device driver component of the computer, if the determining step determines that the content of the received message provides the instruction to the attached printing device; and (4) operating the processor of the attached printing device in response to the transmitted communication. The changes to Claim 1 are supported by the originally filed specification and do not add new matter.

Regarding the rejection of Claim 1 under 35 U.S.C. § 103(a), the Office Action asserts that the ‘694 patent discloses everything in Claim 1 with the exception of an attached printing device, and relies on the ‘421 patent to remedy that deficiency.

The ‘694 patent is directed to a system and method for pushing information from a host system to a mobile communication device having a shared electronic address with the host system. As shown in Figure 1, the ‘694 patent discloses a system in which certain user-defined event triggers are activated and messages are redirected from a desktop computer to a mobile communication device. In particular, as shown in steps 68-72 of Figure 4, regarding incoming e-mail messages, if the messages are to be redirected by the redirector 12, the message is repackaged by placing an outer wrapper around the original message before being forwarded to the user. Further, the ‘694 patent discloses that if the redirector is configured so that the mobile data device cannot receive and process word processor or voice attachments, then the redirector routes those attachments to an external machine that is compatible with a

particular attachment, such as a printer, network fax machine, or telephone.<sup>2</sup> However, Applicants note that *the ‘694 patent discloses that all of the e-mail messages that are redirected by the redirection software 12 are intended to be read or viewed by a user, even if some of the attachments are first printed by a printer before being viewed by a user.*

However, Applicants respectfully submit that the ‘694 patent fails to disclose the step of determining, by the computer, which of the following mutually exclusive conditions is true: (1) a content of the received message is intended to be read or viewed by a user, and (2) the content of the received message provides an instruction to an attached printing device associated with the computer, wherein the instruction to the attached printing device is unrelated to printing of data included in or attached to the received message, and the contents of the received message does not include print data to be printed by the attached printing device, as recited in amended Claim 1. Regarding the sending of an attachment to an attached printing device, the received messages in the ‘694 patent are limited to messages that contain print data to be printed by a printer. However, Applicants note that amended Claim 1 is directed to messages that do not include print data to be printed by the attached printing device, and the instruction to an attached printing device is unrelated to printing of data included in or attached to the printing device.

In this regard, Applicants note that the Office Action on pages 4 and 5 cites to column 8, lines 4-10 of the ‘694 patent as disclosing this limitation and states that “the message characteristic (‘instruction’) … determine[s] whether messages [are] to be redirected to [the] attached printer... .” However, Applicants note that column 8, lines 4-10 of the ‘694 patent state the following:

The preferred list contains a list of senders (other users) whose messages are to be redirected or a list of message characteristics that determine whether a message is to be

---

<sup>2</sup> See, e.g., the ‘694 patent, column 3, lines 48-54.

redirected. If activated, the preferred list mode causes the redirector program 12 to operate like a filter, only redirecting certain user data items based on whether a data item was sent from a sender on the preferred list or has certain message characteristics that if present will trigger or suppress redirection of the message.<sup>3</sup>

Thus, the ‘694 patent discloses a system that checks the sender of a message or other message characteristics to determine if the message should be redirected. However, Applicants respectfully submit that this is not a disclosure of the claimed instruction to an attached printing device, wherein the instruction to the attached printing device is unrelated to printing of data included in or attached to the received message, as recited in Claim 1. It is unclear to Applicants how the disclosure in column 8 relates to the claimed instruction. In this regard, Applicants note that the Office Action seemingly is equating the message characteristics disclosed by the ‘694 patent with the claimed instruction. However, Applicants note that the ‘694 patent’s disclosure of “message characteristics,” is a very broad term and ***the ‘694 patent does not specifically disclose instructions to an attached printing device.*** The ‘694 patent does not teach or suggest that such “characteristics of a message” could include an instruction to an attached device. While the ‘694 patent discloses, in other sections, that messages can be redirected to printers, Applicants note that an instruction to an attached printing device is not the same thing as sending a file to a printing device. However, even assuming *arguendo* that the Office Action is interpreting the ‘694 patent’s disclosure of sending a file or message to a printer as providing an instruction to the printer, Applicants note that ***Claim 1 explicitly states that the instruction to the attached printing device is unrelated to printing of data included in or attached to the received message.*** Thus, Applicants respectfully submit that this language in Claim 1 explicitly excludes the interpretation of “sending a file to a printer” to read on the claimed instruction recited in

---

<sup>3</sup> ‘694 patent, col. 8, lines 3-11.

Claim 1. The '694 patent merely discloses the printing of files on a printer, while the invention recited in Claim 1 is unrelated to printing of files on a printer.

Further, Applicants respectfully submit that the '694 patent fails to disclose transmitting a communication from the computer to the attached printing device through a device driver component of the computer, as recited in amended Claim 1. Applicants respectfully submit that the '694 patent is silent regarding this limitation.

The '421 patent is directed to a method of automatically communicating status information relative to a document production job by a printer, including the steps of creating a page description language file with embedded e-mail information, sending the page description language file to the printer, having the printer detect the embedded e-mail information, having the printer print the print job, and having the printer send status information via e-mail regarding the print job using the embedded e-mail address.

However, Applicants respectfully submit that the '421 patent fails to disclose the step of determining, by the computer, which of the following mutually exclusive conditions is true: (1) a content of the received message is intended to be read or viewed by a user, and (2) the content of the received message provides an instruction to an attached printing device associated with the computer, by detecting a characteristic of the message, wherein the content of the received message does not include print data to be printed by the attached printing device and the instruction to the attached printing device is unrelated to printing of data included in or attached to the received message, as recited in Claim 1. On the contrary, the '421 patent discloses that the embedded e-mail address is related to the reporting of the status of the print job in which the e-mail address is embedded. Further, the message disclosed by the '421 patent is in the form of a page description language file, not an e-mail. Moreover, the information received by the printer in the '421 patent includes print data, and even if the e-mail address embedded in the print data can be interpreted as an instruction, this

“instruction” is related to printing of data included in or attached to the received message, contrary to the limitations recited in amended Claim 1. In this regard, Applicants note that the Office Action appears to merely rely on the ‘421 patent as disclosing an attached printing device that includes a processor.

Further, Applicants respectfully submit that the ‘421 patent fails to disclose the step of transmitting a communication from the computer to the attached printing device through a device driver component of the computer, if the determining step determines that the content of the received message provides the instruction to the attached printing device, as recited in amended Claim 1.

Applicants note that page 2 of the outstanding Office Action states that “...one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references...Applicant obviously attacks references individually without taking into consideration based on the teachings of combinations of references as shown below.” Applicants respectfully disagree with this assessment. In this regard, Applicants note that page 14 of Applicants’ previous response discusses the combination of the combined teachings of the ‘694 and ‘421 patents. In particular, Applicants note that, no matter how the teachings of the ‘694 patent and the ‘421 patent are combined, the combination would not teach or suggest the step of determining, by the computer, which of the following mutually exclusive conditions is true: (1) a content of the received message is intended to be read or viewed by a user, and (2) the content of the received message provides an instruction to an attached printing device, wherein the instruction to the attached printing device is unrelated to printing of data included in or attached to the received message, as recited in Claim 1. Applicants note that the combination is deficient because neither the ‘694 or the ‘421 patents, nor their combination, teach or suggest an electronic mail message that includes an instruction to an attached printing device, wherein the instruction is unrelated to

printing of data included in or attached to the received message, as required by Claim 1. As discussed above, the ‘694 patent merely discloses looking at various message characteristics such as the sender of the message to determine whether the message should be redirected. The ‘421 patent only discloses that a file is sent to a printer, wherein the file has an embedded e-mail address that can be used by the printer to send back information regarding the status of the print job. Thus, the ‘421 patent does not disclose the sending of an e-mail to a printer and does not disclose that any messages are checked to determine where the message should be sent.

Because none of the ‘694 and ‘421 patents, nor their combination, teach or suggest the instruction recited in Claim 1, they must also fail to disclose the step of determining, by the computer, which of two the claimed mutually exclusive conditions are true. None of the cited references teach or suggest the determination recited in Claim 1. Claim 1 requires that the computer determine which of two conditions are true: (1) that the content of the received message is intended to be read or viewed by a user, and (2) the content of the received message provides an instruction to an attached printing device, wherein the instruction is unrelated to printing of data included in or attached to the received message. While the ‘694 patent discloses the redirection of an e-mail message based on certain criteria, it does not contemplate the sending of instructions to a printer and does not contemplate that a message might not be for a user. All of the messages disclosed by the ‘694 patent are intended to be read by a user, even if they are first printed. Thus, it would be impossible for the ‘694 system to make a determination that the content of a received message was not intended to be read or viewed by a user.

For the reasons stated above, Applicants respectfully submit that the rejection of Claim 1 (and all similar rejected dependent claims) is rendered moot by the present amendment to Claim 1.

Further, *Applicants request that, in any future Office Action, the Office Action explicitly indicate how the ‘694 patent teaches or suggests that the redirection software 12 makes a determination that the content of a received message is not intended to be read or viewed by a user*, as implied by the language of Claim 1. The language of Claim 1 requires that a determination be made as to which of two mutually exclusive conditions are true, one of the conditions implicitly requiring that the received message is not intended to be read by the user, but instead provides an instruction to an attached printing device.

Further, *Applicants respectfully request that, in any future Office Action, the Office explicitly indicate how the ‘694 patent discloses an instruction to an attached printing device, wherein the instruction to the attached printing device is unrelated to printing of data included in or attached to the received message*, as required by Claim 1. Applicants note that the citation of column 8 is deficient and says nothing about an instruction, but merely refers to message characteristics. In this regard, Applicants note that Claim 1 recites both characteristics of the message and an instruction to an attached printing device. Applicants respectfully submit that the ‘694 patent is silent regarding any type of instruction to an attached printing device, wherein the instruction is unrelated to printing of data included in or attached to the received message, and Applicants respectfully request that the Office provide specific references to the ‘694 patent to rebut Applicants’ assertion.

Because the combined teachings of the ‘694 and ‘421 patents fail to disclose the determining step recited in Claim 1, they must also fail to disclose the means for determining recited in Claim 23. Accordingly, Applicants respectfully submit that the rejection of Claim 23 (and all similarly rejected dependent claims) is rendered moot by the present amendment to Claim 23.

Regarding the rejection of dependent Claims 11, 16, 17, 30, 38, 39, and 47 under 35 U.S.C. § 103, Applicants respectfully submit that the ‘492 and ‘636 patents fail to remedy the

deficiencies of the '694 and '421 patents, as discussed above. Accordingly, Applicants respectfully submit that the rejections of the above-noted dependent claims are rendered moot by the present amendment to Claims 1 and 23.

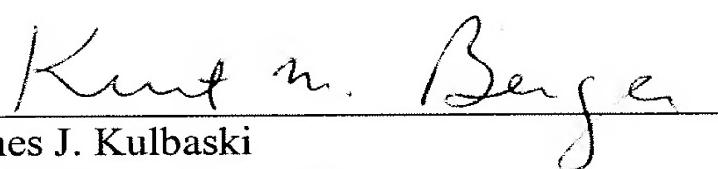
The present amendment also sets forth new Claim 54 for examination on the merits. New Claim 54 is directed to a method for receiving information of an attached business office device at a remote center through the Internet. New Claim 54 is supported by the originally filed specification and does not add new matter.<sup>4</sup>

Thus, it is respectfully submitted that independent Claims 1 and 23 (and all associated dependent claims) patentably define over any proper combination of the '694, '421, '492, and '636 patents.

Consequently, in view of the present amendment and in light of the above discussion, the outstanding grounds for rejection are believed to have been overcome. The application as amended herewith is believed to be in condition for formal allowance. An early and favorable action to that effect is respectfully requested.

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,  
MAIER & NEUSTADT, P.C.

  
\_\_\_\_\_  
James J. Kulbaski

Registration No. 34,648  
Attorney of Record

Kurt M. Berger, Ph.D.  
Registration No. 51,461

Customer Number  
**22850**

Tel: (703) 413-3000  
Fax: (703) 413 -2220  
(OSMMN 03/06)

JJK/KMB:sjh

I:\ATTY\KMB\5244\5244-0084\52440084-AM 11-22-07.DOC

<sup>4</sup> See, e.g., Fig. 5 and the discussion related thereto in the specification.